

### **Remarks**

This Response is considered fully responsive to the Final Office Action mailed March 7, 2007. Claims 1-15 and 21-25 were pending in the application. Claims 1-15 and 21-25 stand rejected. In this Response, claims 1, 7, 11, and 13 have been amended to clarify claim language, claim 21 has been amended to incorporate the features previously found in dependent claim 23, and claim 23 has been cancelled. No claims have been added, and no new matter has been added. Claims 1-15, 21, 22, 24, and 25 are now pending in the application. Reexamination and reconsideration are requested.

Applicants request entry of this Rule 116 Response to Final Office Action because it is believed that the amendment of claims 1, 7, 11, 13, and 21 and the cancellation of claim 23 place this application into condition for allowance. The Manual of Patent Examining Procedure (MPEP), §714.12 states "Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered."

### **Request to Withdraw Finality of Office Action**

MPEP §706.07(a) states "[u]nder present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." In the first Office action, the Office specifically quoted language in U.S. Patent Application Publication No. 2001-0055172 to Yip, et al. ("Yip") relating to "clusters" and specifically omitted language relating to "zones" in support of the rejection of claims 1-15 and 21-25. However, in response to Applicants' arguments, the Office appears to switch the ground for rejection by stating "Zones, as disclosed by Yip, are therefore equivalent to windows, as recited in the claims." As such, Applicants respectfully submit that, in the present Office Action, the Office has effectively introduced new grounds of rejection by making assertions in the Office's "Response to Arguments" which are not articulated in, supported by, or consistent with the rejection of the claims in the first Office Action or the outstanding Final Office Action.

In both Office Actions, the Office has merely cited portions of paragraphs in Yip and alleged that those paragraphs teach the recited features of the claims. At no point in either Office Action has the Examiner provided any explanation of how the quoted portions of the cited art

relate to the features of the claims or even to the Office's use of Yip's zones as support for the rejection. Furthermore, the Office's omission of "zones" from the quoted language expressly suggests that the rejection was based on clusters-as-windows, not zones-as-windows.

MPEP 706.07(b) states "In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof." Absent from the rejections of the instant claims is any explanation of the rejections or reasons in support thereof. For at least these reasons, Applicants respectfully submit that the finality of this Office Action is premature and request that it be withdrawn.

### **Rejections Under 35 U.S.C. § 102**

The Examiner has rejected claims 1-15 and 21-25 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2001-0055172 to Yip, et al. ("Yip"). All rejections are respectfully traversed.

Amended independent claim 1 recites, *inter alia*, "determining whether the location of an identified defect is within a predetermined window defined relative to another identified defect location on the media surface" and "if the location is within the predetermined window, characterizing the defects in the window as a scratch."

Amended independent claim 7 recites, *inter alia*, "determining whether one or more defect locations lies within a predetermined window defined relative to another defect location."

Amended independent claim 11 recites, *inter alia*, that the controller "determines whether the location of an identified defect is within a predetermined window defined relative to another identified defect location on the media surface," and "characterizes the defects in the window as a scratch, if the location is within the predetermined window."

Amended independent claim 21 recites, *inter alia*, that "a scratch includes one or more defects within a predetermined window defined relative to another identified defect."

At pages 2, 4, and 7 of the final Office Action, the Office contends that these features are taught by Yip, and Yip at paragraph [0022] is repeatedly cited in support of this contention. Applicants, however, respectfully disagree.

Each of independent claims 1, 7, 11, and 21 use an identified defect location as a frame of reference for characterizing a scratch. Specifically, in each of the claims, identified defects are characterized as part of a scratch if they fall within a predetermined window defined relative to

another identified defect. Applicants respectfully submit that Yip fails to teach that defects within a predetermined window defined relative to another identified defect are characterized as a scratch.

In the Examiner's Response to Arguments, it now appears that the Office equates the "zones" of Yip with the predetermined windows defined relative to another identified defect. Applicants respectfully disagree. According to Yip at paragraph [0022], "tracks may be grouped into zones with data written at different rates for the various zones, using the known technique of zone bit recording." Thus, the zones of Yip are merely different physical locations within, for example, a disc drive. The zones of Yip are characterized as having different read and write rates. Zones, in contrast to the predetermined windows recited in the present pending claims, are not defined relative to identified defects.

Yip also teaches "[a]ll the defective sectors in the same zone are grouped into one or more clusters." Yip at paragraph [0022]. Yip, however, fails to teach any method of grouping defective sectors into one or more clusters. Further, Yip teaches that clusters can be of different sizes (*see* Yip at Fig. 5) within a zone. Accordingly, the clusters of Yip can not be equated to the predetermined window defined relative to another identified defect, as recited in the independent claims. Thus, Yip fails to teach the determination of whether one identified defect is within a predetermined window defined relative to another identified defect, as in the independent claims.

Yip merely teaches that defective sectors within a zone defined by the technique of zone-bit recording are grouped into clusters, and that the representation of a group of defective sectors can be compressed by defining a pattern. Thus, Yip fails to teach characterization of an identified as part of a scratch if they fall within a predetermined window defined relative to another identified defect. For at least these reasons, Applicants respectfully submit that Yip fails to teach the aforementioned features of independent claims 1, 7, 11, 21, and those claims depending directly or indirectly therefrom.

Further, with respect to independent claims 7 and 11, the Office has alleged that Yip teaches assigning a unique scratch index or unique index entry to each scratch. Applicants respectfully disagree.

At page 9 of the Office Action, the Office contends that "[s]ince the parameters of the scratch are unique, this is equivalent to a unique scratch index. Thus, Yip effectively teaches "assigning a unique scratch index to each defect location within the predetermined window."

The parameters shown, for example, in Table 2 of Yip are descriptive. They describe the physical parameters and location of the scratch. Such descriptive parameters are not assigned to each defect location within the predetermined window. Further, as discussed above, Yip fails to teach a predetermined window that is defined relative to another identified defect. For at least these reasons, and those set forth above, Applicants respectfully submit that Yip fails to teach at least the aforementioned features of independent claims 7 and 11, and those claims depending directly or indirectly therefrom.

Applicants note that MPEP 2131 states that "A claim is anticipated only if **each and every element as set forth in the claim is found**, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (Emphasis added). Thus, in order to anticipate the present pending claims, the Yip reference must teach each and every element of the claims. Applicants respectfully submits that Yip fails to do so.

Accordingly, Applicants request favorable reconsideration and withdrawal of the rejection of independent claims 1, 7, 11, 21, and those claims depending directly or indirectly therefrom. Allowance of claims 1-15, 21, 22, 24, and 25 is respectfully requested.

### **Conclusion**

Claims 1-15, 21, 22, 24, and 25 are currently pending in the application. Applicant has fully responded to each and every objection and rejection in the Final Office action dated March 7, 2007 and believes that claims 1-15, 21, 22, 24, and 25 are in a condition for allowance. Applicant therefore requests that a timely Notice of Allowance be issued in this case.

Applicants believe no other fees or petitions are due with this filing. However, should any such fees or petitions be required, please consider this a request therefor and authorization to charge Deposit Account No. 50-3199 as necessary.

If the Examiner should require any additional information or amendment, please contact the undersigned attorney. If the Examiner believes any issues could be resolved via a telephone interview, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

May 7, 2007

/Richard J. Holzer, Jr./  
Richard J. Holzer, Jr., Reg. No. 42,668  
Attorney for Applicant  
USPTO Customer No. 64776

HENSLEY KIM & EDGINGTON, LLC  
1660 Lincoln Street, Suite 3050  
Denver, Colorado 80264  
Tel: 720-377-0770  
Fax: 720-377-0777